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10/021,171	12/12/2001	David Grabelsky	01-1719	1393

7590 11/27/2007  
McDonnell Boehnen Hulbert & Berghoff  
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EXAMINER
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SIDDIQI, MOHAMMAD A

ART UNIT	PAPER NUMBER
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2154

MAIL DATE	DELIVERY MODE
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11/27/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/021,171

Applicant(s)

GRABELSKY ET AL.

Examiner

Mohammad A. Siddiqi

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08/31/2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

1. Claims 1-15 presented for examination. Claims 16-35 have been withdrawn.

***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08/31/2007 has been entered.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for

patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-15 are rejected under 35 U.S.C. 102(e) as being Anticipated by Requena et al. (US 2002/0126701) (hereinafter Requena).

5. As per claim 1, Requena discloses a method for providing instant services in an Internet Protocol network, the method comprising:

provisioning a first communication session between a first user terminal and a predetermined network device (CSCF SIP Server, fig 8, page 11, para #0182- #0186);

provisioning a second communication session between a second user terminal and the predetermined network device (CSCF SIP Server, fig 8, page 11, para #0182- #0186);

identifying an intended recipient and initiating an activation request (NOTIFY, Fig 11, page 13, para #0021-#0226);

receiving the activation request to establish an active communication session between the first user terminal and the second user terminal (Jane and Jose, Fig 11, page 13, para #0021-#0226);

bridging the first communication session to the second communication session on the predetermined network device (Fig 11, page 13, para #0021-#0226).

6. As per claim 2, Requena discloses a computer readable medium having stored therein instructions to execute the method of claim 1 (CSCF SIP server, fig 11).

7. As per claim 3, Requena discloses the first communication session comprises a first real-time transport protocol session, and the second communication session comprises a second real-time transport protocol session (SIP, fig 11, page 12, #0218).

8. As per claim 4, Requena discloses receiving a first registration request from a user associated with the first user terminal (fig 8, page 11, para #0182);

authenticating the first user in accordance with a first user account for the user associated with the first user terminal (SIP security mechanism, Page 11, para #0186);

receiving a first subscription request from the user associated with the first user account, wherein the first subscription request comprises a request

to subscribe to a first service (col 17; lines 29-35; 55-63).

9. As per claim 5, Requena discloses the first service comprises a multimedia service (col 2; lines 57-67; col 2 lines 1-3; col 7, lines 57-59).

10. As per claim 6, Requena discloses the multimedia service comprises an instant voice messaging service (fig 11, page 13, para #0221-#0226).

11. As per claim 7, Requena discloses receiving a first registration request from a user associated with the second user terminal (fig 11, page 13, para #0221-#0226);

authenticating the user in accordance with a first user account for the user associated with the second user terminal (SIP security mechanism, fig 11, Page 11, para #0186; page 13, para #0221-#0226);

receiving a first subscription request from the user associated with the second user terminal, wherein the first subscription request comprises a request to subscribe to the first service using a first subscriber identification (see session establishment between Jane and Jose using SIP, fig 11, page 13, para #0221-#0226

12. As per claim 8, Requena discloses receiving a second subscription request from the user associated with the second user terminal, wherein the second subscription request comprises a request to subscribe to the first service using a second subscriber identification (see session establishment between Jane and Jose using SIP, fig 11, page 13, para #0221-#0226);

provisioning a third communication session between the second user terminal and the predetermined network device (see session establishment between Jane and Jose using SIP, fig 11, page 13, para #0221-#0226).

13. As per claim 9, Requena discloses of claim 1, further comprising:

providing a first list of subscribers to the first user terminal, the first list of subscribers including subscriber identifications associated with active subscribers authorized to communicate with the user associated with the first user terminal (fig 11, page 13, para #0221-#0226); and

providing a second list of subscribers to the second user terminal, the second list of subscribers including subscriber identifications associated with active subscribers authorized to communicate with the user associated with the second user terminal (fig 11, page 13, para #0221-#0226).

14. As per claim 10, Requena discloses the first user terminal comprises a signaling agent, and the step of receiving the request to establish an active

communication session between the first user terminal and the second user terminal comprises:

receiving a user input to establish the active communication session to the second user terminal (session between Jane and Jose, fig 11, page 13, para #0221-#0226);

sending the request to establish the active communication session between the first user terminal and the second user terminal from the signaling agent to the predetermined network device (session between Jane and Jose, fig 11, page 13, para #0221-#0226).

15. As per claim 11, Requena discloses the signaling agent comprises a Session Initiation Protocol (SIP) agent (SIP signaling, fig 11, page 4, para #0071).

16. As per claim 12, Requena discloses the first user terminal is associated with a virtual signaling agent, and the step of receiving the request to establish an active communication session between the first user terminal and the second user terminal comprises:

receiving on the first user terminal a user input to establish the active communication session to the second user terminal (SIP signaling, fig 11, page 13, para #0221-#0226);



sending to the virtual signaling agent a request to establish the active communication session (SIP signaling, fig 11, page 13, para #0221-#0226); sending from the virtual signaling agent to the predetermined network device the request to establish the active communication session between the first user terminal and the second user terminal (SIP signaling, fig 11, page 13, para #0221-#0226).

17. As per claim 13, Requena discloses receiving a request to terminate the active communication session between the first user terminal and the second user terminal (Jane and Jose, fig 11, page 13, para #0221-#0226); and

un-bridging the first communication session from the second communication session on the predetermined network device (Jane and Jose, fig 11, page 4, para 3, #0071; page 13, para #0221-#0226).

18. As per claim 14, Requena discloses the step of provisioning the first communication session and the second communication session comprises setting up the first and second communication sessions between the first and second user terminals and the predetermined network device prior to receiving the receiving the activation request (fig 11, page 13, para #0221-

#0226).

19. As per claim 15, Requena discloses the first user terminal is associated with a first predetermined device and the second user terminal is associated with a second predetermined device (jane and Jose fig 11).

### ***Response to Arguments***

20. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

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US 2002/0126701

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohammad A. Siddiqi whose

telephone number is (571) 272-3976. The examiner can normally be reached on Monday -Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J. Flynn can be reached on (571) 272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MAS